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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,983	09/24/2003	Larry L. Griffin	DIALP.001A	9741
20995	7590	06/06/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			FISCHMANN, BRYAN R	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3618	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/669,983		GRIFFIN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Bryan Fischmann		3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09-24-03</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

***Specification***

1. The specification is objected to because of the following:

A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

1) Paragraph 0002 recites "oppose a personal touch". The word "oppose" when read in context, seems inconsistent with surrounding text.

2) Paragraph 0005 discloses "Numerous kits are presently on the market for replacing original rear fender assembly with a larger assembly that can accommodate a larger tire...".

Request Applicant disclose any known kits that are relevant prior art, preferably on an Information Disclosure Statement.

Not also, that to be grammatically correct, the word "an" should appear before the word "original" in the above recitation.

B) The following inconsistencies in nomenclature were noted:

1) Paragraph 0026 recites "headlight 28" and "gauge cluster 28".

2) Paragraph 0042 recites "centerline 78". Paragraphs 0044 and 0045 recites center plane "0078".

To avoid confusion to the reader, and to facilitate identifying components by nomenclature in the claims, it is requested Applicant use consistent nomenclature for the same reference number throughout the specification.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "28" has been used to designate both a headlight and a gage cluster.
3. Figures 5-8 are objected to, as Figures 5-8 are photographs that are considered to be of "poor quality" as they are too "grainy". See 37 CFR 1.84(b).
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign not mentioned in the description: R. Correction is required.
5. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Note that in addition to the photograph quality of Figures 5-8, that the reference numbers and associated lead lines are not uniform and well defined. See 37 CFR 1.84(p).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

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any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

A) Claim 5 recites "...the first offsetting portion defining...(a)...larger man and offset...".

The meaning of this recited phrase is considered unclear.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 9 and 10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Scherbarth, US Patent 6,257,362.

Scherbarth teaches a fender bracket kit (Figure 2) for a motorcycle comprising first and second brackets (52 – see Figure 4) including first and second frame mounting

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points (54), respectively, configured for mounting (Figure 1) the brackets to a frame (12) of a motorcycle, the first and second brackets including third and fourth (58) mounting points for supporting a rear fender (32) over a rear tire of the motorcycle, the first and second brackets being configured to support the fender such that a centerline (transverse) of the fender is offset (Figure 1) from a centerline (transverse) of the frame.

Regarding claim 4, claim 4 may be satisfied if the "first offset bracket" is selected to be reference 52 and the second offset bracket is selected to be reference number 26.

10. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Price, Sr., US Patent 5,299,832.

Price teaches a kit for changing the location of a rear fender of a motorcycle comprising means for laterally offsetting a rear fender of a motorcycle.

Note that Price teaches a "clamp-on" fender, such that the fender may be "laterally offset" from the motorcycle, when the fender is moved laterally from an installed position, to an "uninstalled" position laterally from the motorcycle, or vice versa.

Regarding claim 12, claim 12 is met when the fender is moved laterally from an uninstalled, to an installed position, where the longitudinal centerlines of the fender and tire coincide.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price, Sr., US Patent 5,299,832.

Price teaches a method (see comments below) for mounting a motorcycle fender. Price fails to explicitly state that the method may be used to increase the maximum size of a tire that can be mounted to a motorcycle.

However, the Examiner takes Official Notice that tires for motorcycles, as well as automobiles, come in different "sizes", such as heights and widths. This may be seen at any tire store. Having a wider tire is advantageous in the acceleration of the vehicle is improved, if the tire is connected to a power source for propelling the vehicle. A wider tire is also advantageous in that "float" in soft surfaces, such as sand is improved. Having a tire with a larger, or smaller height (from rim OD to tire OD) is advantageous in that the height may be varied to suit the preferences of the user. A smaller height improves performance in turns and a larger height increases rider comfort.

Note that when a larger, or smaller tire height is utilized on the motorcycle of Price, that the fender will need to be moved vertically in order to maintain a proper clearance between tire OD and the lower surface of the fender.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the method of mounting a motorcycle fender of Price may be utilized to increase the size of a tire, such as the height.

Regarding the method of recited in claim 13, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to include the claimed method of mounting a motorcycle fender taught by Price. Because the prior art discloses all the structure necessary to perform the claimed functions, one of ordinary skill in the art would find the claimed method to be an obvious step in light of the disclosed structure. See MPEP §2112.02. See also *In re King*, 801 F2d 1324, 1326; 231 USPQ 136, 138 (Fed Cir 1986).

Regarding the claim 13 recitation "mounting the fender so as to offset the rear fender from the center plane of the frame", Note when a larger "height" tire is mounted on the motorcycle of Price, Sr, that the fender will be relocated upward, by repositioning the mounting clamp (Figure 2). Note by repositioning the mounting clamp, that the fender will be offset vertically from a "center plane" of the frame, that is a horizontal plane through a vertical centerline of the frame.

### ***Allowable Subject Matter***

13. Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Motojima, et al – teaches mounting of a motorcycle fender



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B) Kawashima, Ishino, et al, Bourget and Friesen – teach mounting of an  
oversize wheel on a motorcycle

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (571) 272-6694. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5-28-5  
**BRYAN FISCHMANN**  
**PRIMARY EXAMINER**